Supreme Court, U. S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

No. 79-1556

CANRON, INC.,

Petitioner,

vs.

PLASSER AMERICAN CORPORATION,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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This is a routine patent case of interest only to the litigants. Petitioner comes to this Court with adverse findings of fact, conclusions of law and a judgment of the trial court which has the full concurrence of the Court of Appeals per curiam. That Court affirmed "on the trial court's comprehensive Findings of Fact and Conclusions of Law" (A-3). None of the reasons outlined in Rule 19 govern the petition.

The petition presents no principle of importance to the public as distinguished from that of the parties and asserts no real and embarrassing conflict of opinion and authority between different Courts of Appeals. The Petition for the Writ of Certiorari should be denied on the authority of *Layne & Bowler Corp.* v. *Western Well Works,* 261 U. S. 387 at page 393 (1923).

Petitioner's complaint is that its minor patent was held invalid under 35 USC 102(b) because it was "anticipated" by more than one reference whereas the Fourth Circuit in *Tights, Inc.* v. *Acme-McCrary Corp.*, 541 F. 2d 1047 (4th Cir. 1976), *Cert. Denied*, 429 U. S. 980 (1976) said that anticipation requires a full disclosure in one reference. Petitioner contends that the holding here conflicts with *Tights* and with the decisions of virtually all of the Circuit Courts of Appeal which have required that an anticipation under 35 USC 102(b) calls for a full disclosure in a single reference. Petitioner dramatizes this in a chart on page 4 of its Petition where it purports to portray some nine references allegedly used by the District Court against the elements of the principal claims of its patent.

Petitioner fails to point out that four of the references are Petitioner's own prior art publications disclosing its own machine. Three of the publications are *identical* to what is shown in the patent (Exhibits B-20, A-20 and U). These are all publications concerning the same machine disclosing different aspects of it with a good deal of overlap. These constitute one publication although serialized. A series of publications on the same machine by the same source qualify as a "single publication", see *Deep Welding, Inc.* v. *Sciaky Bros., Inc.*, 417 F. 2d 1227, 1239 (7th Cir. 1969).

Petitioner's own prior art publications, either singly or as a group, constitute a complete anticipation. The prior art description must be sufficient to enable one to make the invention, see *Seymour* v. *Osborne*, 78 U. S. (11 Wall) 516, 20 L. Ed. 33 (1871) and *Cohn* v. *United States Corset*, 93 U. S. 366, 23 L. Ed. 907 (1876). Such was the case here.

Petitioner forfeited his right to a patent by distributing his own printed publications of the precise subject matter of the patent more than one year before his U. S. filing date in violation of 35 USC 102(b). The requirement of 35 USC 102(b) is the very foundation of the patent system—the government's grant of a limited monopoly in return for an early disclosure to

the public of the patented subject matter. *Pennock* v. *Dialogue*, 27 U. S. (2 Pet.) 1, 7 L. Ed. 327 (1829). This statutory provision is bottomed on three policies; first, to avoid detrimental public reliance upon a product appearing in the public for a significant period of time without an assertion of patent rights; second, to encourage prompt disclosure of new and useful information; and, third, to discourage attempts to extend the length of the patent by commercially exploiting a new invention and only applying for a patent when faced with competition.

Petitioner has violated the basic purpose of the patent system —filing his patent application over one year after publicizing the subject matter thereof. He has forfeited his rights.

Petitioner's patent was also anticipated under 35 USC 102(b) by one of respondents prior patents (Exhibit 86). The other four references in petitioner's chart on page 4 of its petition merely illustrated minor unimportant details and were used under 35 USC 102(b) in the sense of *Struthers Scientific & International Corporation* v. *Rappl & Hoenig Co., Inc.*, 453 F. 2d 250, 254 (2nd Cir. 1972).

In summary, respondent urges that the District Court properly dismissed Petitioner's complaint and granted appropriate relief under the circumstances. The Court of Appeals properly ruled with respect to all matters of which complaint has been made in the petition. There is no conflict here with decisional law of this or any other circuit. The issues present no matters of general public interest. The Petition should, we submit, be denied.

Dated, Chicago, Illinois this ..... day of ....., 1980.

Respectfully submitted,

ALFRED H. PLYER, JR.,
Attorney for Respondent.